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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,015	12/29/2000	Peter Perthou	08914-009001	1179
26161	7590	04/30/2008	EXAMINER	
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P.O. BOX 1022				
MINNEAPOLIS, MN 55440-1022			ART UNIT	PAPER NUMBER
			3673	
			MAIL DATE	DELIVERY MODE
			04/30/2008	PAPER

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1                   **RECORD OF ORAL HEARING**  
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3                   **UNITED STATES PATENT AND TRADEMARK OFFICE**  
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6                   **BEFORE THE BOARD OF PATENT APPEALS**  
7                   **AND INTERFERENCES**  
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10                  **Ex parte PETER PERTHOU**  
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13                  Appeal 2007-2838  
14                  Application 09/752,015  
15                  Technology Center 3600  
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18                  Oral Hearing Held: April 10, 2008  
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22                  Before TERRY J. OWENS, HUBERT C. LORIN, and JOHN C. KERINS,  
23                  Administrative Patent Judges

24

25                  ON BEHALF OF THE APPELLANT:

26

27                  CHARLES HEIKEN, ESQUIRE  
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32

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34                  The above-entitled matter came on for hearing on Thursday, April 10, 2008,  
35                  commencing at 9:00 a.m., at the U.S. Patent and Trademark Office, 600  
36                  Dulany Street, Alexandria, Virginia, before Ashorethea Cleveland, Notary  
37                  Public.

1                           P R O C E E D I N G S  
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3                   MR. HIEKEN: Good morning, Your Honors. May it please the  
4                   Board. This is a second appeal from a final rejection of Claim 1-11 on Mr.  
5                   Perthou's design patent for double patenting and Claims 1, 6 and 11 under  
6                   103, over Chin as a primary reference, Jung, a second reference, Momemers  
7                   or Sheldon as a tertiary and then two through five and seven through ten  
8                   further in view of Miller.

9                   I would like to discuss the prior art, the differences and the law but  
10                  starting out with the design patent. Of course, that's extremely narrow.

11                  A design patent only covers the actual design as shown, extremely  
12                  narrow and it's extremely difficult to have a double patenting rejection on  
13                  the basis of a design patent, and we have set forth, I think, cases which  
14                  support that.

15                  Going into the Chin patent, the Chin patent shows nothing but two  
16                  rings joined by a strap. The Jung shows a nail clipper with a key ring  
17                  attached by a wire that's bent at a 90-degree angle, and then it has the ends  
18                  turned in slightly so that they will fit into little holes, into the solid body of  
19                  the actual nail clipper that's involved. And Momemers shows the  
20                  key-keeper; Sheldon some kind of a key identifier. Miller shows some kind  
21                  of a -- with a stitched end.

22                  So, what are the differences in the structure? Well, the claimed  
23                  invention calls for a D-ring that is really connected between the key ring and  
24                  the band. And the other claims also call -- it also calls for a bore in there,  
25                  that is in the D-ring portion.

1        There are dependent claims which call for a gap and the gap is very  
2 specifically defined as it is a narrow gap which corresponds substantially to  
3 the width of the actual ring that you'd have there so that it makes it possible  
4 during construction to move that ring through that little gap.

5        And then there's also the method in claim one, and there's just nothing  
6 in the references that describes the method in there.

7        Now, if we kind of go to the law that is involved: In rejecting claims,  
8 of course, the Examiner bears the initial burden of presenting a prima facie  
9 case of obviousness. You'll find that in *In re Rijckaert* which is at 9 Federal  
10 3rd, 1531, 1532, which cited *In re Oetiker* at 97-7 F.2nd 1443, 1445.

11       Then we of course have KSR and KSR made a statement and this is at  
12 82 USPQ 2nd, 1385 and I believe this is 1396. "Often it will be necessary  
13 for a court to look to interrelated teachings of multiple patents. The effects  
14 of demands known to the design community are present in the marketplace  
15 and the background and knowledge possessed by a person having ordinary  
16 skill in the art all in order to determine whether there was an apparent reason  
17 to combine the known elements in the fashion claimed by the patent at  
18 issue."

19       "To facilitate review the analysis should be made explicit. See *In re:*  
20 *Kahn*." And that's Federal Circuit, a 2006 decision at 441 Fed. 3rd 977, 988.  
21 And they're quoting from it: "Rejections on obviousness grounds cannot be  
22 sustained by mere conclusory statements. Instead there must be some  
23 articulated reasoning with some rational underpinning to support the legal  
24 conclusion of obviousness."

25       Then they went on to caution against hindsight. This is on page 1397:  
26 "A fact-finder should be aware, of course, of the distortion caused by

1 hindsight bias and must be cautious of argument reliant upon ex-post  
2 reasoning." See Graham, 383 U.S. 36, parens, "warning against a  
3 'temptation to read into the prior art the teachings of the invention in issue'  
4 and instructing courts to 'guard against slipping into the use of hindsight."  
5 Parens, 'quoting Monroe Auto Equipment Company v. Hikens  
6 Manufacturing and Supply Company, 332 Fed. 2nd 406, 412, 6th Circuit,  
7 1964.

8 That's basically what has been done here as the use of hindsight.

9 There's also the case of In re Fritt which says you can't use the claim  
10 being rejected as a template or basically a blueprint for attempting to read  
11 the claim on prior art.

12 Then there's another case. Years ago, Examiner and Chief Hennen  
13 came to Boston to give us a talk and I asked him a question: Well, what  
14 about a situation where when you put together the supposed combination of  
15 elements in the prior art you don't come out with what is claimed? And he  
16 responded back: That's one of the strongest reasons for overcoming the  
17 rejection under Section 103.

18 We don't find too many cases on it but there is Ex parte Kusko, 215  
19 USPQ 972, by this Board back in 1981; and then they said on page 974,  
20 "Although we find nothing before us indicating why it would be desired to  
21 combine the references in the manner urged by the Examiner, it is clear to us  
22 that such a modification by itself would not result in that which is set forth in  
23 the claims."

24 Now, to look at the reference, what the Examiner has apparently done  
25 is to read that Jung element which is a triangular -- if you look at it in plan,  
26 it's more of a triangular thing. But it's really a wire bent at a 90-degree

1 angle, and you'll find that the ends are bent in a little so they fit in holes  
2 inside the nail clipper. So, that can't be regarded as D-clip.

3       But one of the first things that an Examiner must do and must be done  
4 in these situations is: We need to be able to interpret the claims. And  
5 certainly the Examiner is entitled to a broad, reasonable interpretation. But  
6 there's no way that you could read that structure as a D-ring.

7       There's another thing that the Examiner said: Well, the drawings are  
8 identical. But they're not identical because of Fig. 3 in the utility application  
9 is different from F. 3 in the design patent.

10       Figure 3 in the utility application shows in dotted lines that bar that  
11 completes the "D" and it shows the small gap in there. It's labeled. It's  
12 described in there.

13       And the Examiner says: Well, the secondary reference, Jung, shows  
14 the gap. But that isn't the type of language that is being in the dependent  
15 claims in defining the gap.

16       The gap has been specifically defined in the dependent claims where  
17 it's referred to as being this narrow gap that's about the width of the  
18 cross-section of the key ring that's actually connected there.

19       The law also is that a reference is only good for what it clearly and  
20 definitely discloses; and those two cases are In re: Hughes and In re:  
21 Morton. I don't happen to remember the cites offhand.

22       But it's pretty clear that the references don't say anything about how  
23 you're going to put this together as it's been set forth in the method claim.  
24 And if you go to ex parte, Ruben and Wiley say, well, in absence of the  
25 novel product in a prior art, the method of producing it is really not very

1 obvious. So, they overcame the rejection of the method claim in that  
2 particular case. And that's the same thing that should happen here.

3 It's clearly clear that it is a novel product because the Examiner has to  
4 put together three or four references to reject every claim.

5 None of the references showed that structure as it is. It has certain  
6 advantages in that you can see that that bar in the D-ring in which the web is  
7 fastened will tend to give lateral rigidity to the web as a convenient way to  
8 hold the key ring, that you can have the keys go in just about every direction  
9 because of the way that it can rotate about that U-shaped portion of the key  
10 ring and all.

11 Then, of course, there is another element that is recited in some of the  
12 dependent claims which call for a clamp which is "14" in the drawing.

13 Well, the Examiner has said, well, Miller shows it's something  
14 stitched together and therefore that is a clamp. That's not a clamp. That's  
15 really not a reasonable interpretation of the plain language.

16 We have cited probably the leading case on what you've got to do in  
17 order to sustain a double patenting rejection on a design patent. And that  
18 was a case that was reversed for concluding that there was double patenting.  
19 But this Dembicza case at 50 USPQ 2nd 1614 -- let's see what page. I  
20 guess I don't quite have a page. But they said, in order for a design to be  
21 unpatentable because of obviousness there must first be a basic design  
22 referenced in the prior art, the design characteristics of which are basically  
23 the same as the claimed design.

24 And then you go on. You must double read. They said that you have  
25 to double read. That is the claim in the design patent and the claims in the  
26 utility patent have to be such that each is obvious over the other.

1           JUDGE KERINS: Counsel, with respect to the design patent, can you  
2 point to specific features that you say are in the claim of the design patent  
3 that are not found in the claimed art design?

4           MR. HIEKEN: Yes, Your Honor. Just as it is, it would be the bar in  
5 the "D."

6           Now, the Examiner has pointed to something there which he calls the  
7 bar; but you can't really see the bar in the design patent.

8           JUDGE KERINS: Well, I'm asking: The claim of the design patent is  
9 to -- here, what is shown here.

10          MR. HIEKEN: Correct.

11          JUDGE KERINS: So, what is in the appearance there? What feature  
12 and appearance here does not appear in any one of the cases on appeal? I  
13 think you've gone in the reverse. You've said --

14          MR. HIEKEN: Okay. If one wants to look at it, let's say, first of all,  
15 of course, it's fair to say that claim one of the utility patent is going to cover  
16 what is disclosed in the design patent.

17          But one of the things that has to be in the design patent is the  
18 appearance of that web there; whereas, if you look at claim one, it is not  
19 restricted to any particular appearance.

20          For example, if you punched a bunch of holes in the web of that, that  
21 would not infringe the design patent. If you look at the design patent, it's  
22 very, very, very narrow protection on it.

23          It's practically impossible to find a double patenting involving a  
24 design patent.

1        There is the case where the court said that in evaluating a design  
2    patent for infringement, one of the things that you're supposed to do is you're  
3    supposed to first come up with a construction of the design patent claim.

4        Well, the Examiner here who has the burden of proving this  
5    obviousness made no construction, made no showing of the double reading,  
6    other than saying, "Well, the drawings are the same. Therefore, they must  
7    be covering the same thing." But they really don't. I think that's pretty clear.  
8    The design patent claim is patentable over the claims in the utility patent.

9           JUDGE OWENS: The band in the design claim is very basic. Why  
10   wouldn't that have been suggested by the term "a band" in your claim, claim  
11   one?

12          MR. HIEKEN: You could have thousands and thousands of varieties  
13   of it.

14          JUDGE OWENS: But it seems like that's about one of the most basic  
15   ones; about as basic as it could get. Why wouldn't that have been  
16   suggested?

17          MR. HIEKEN: Because just looking at a band in there -- what kind  
18   would you do? It may be a particular type. But the question is -- let's even  
19   assume that it might be. The question is, is the narrow design patent claim  
20   patentable over claim one? That's what the courts have looked at.

21          As long as you can find that the design, the very, very narrow design  
22   patent claim is patentable over a utility patent claim, you cannot have this  
23   double reading.

24          JUDGE LORIN: But if the basic band -- if a design would have been  
25   obvious then why would it have been patentable?

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1           MR. HIEKEN: Because you also have to look at all the other features  
2   in it in terms of appearance. For example, you have to have the clamp at the  
3   end of it in the design. That's not in claim one. That is a design feature  
4   which you'd have to have there. It's not in claim one.

5           Design patent claims are very, very narrow. Carmen. Dembicza.  
6   As far as we can tell -- as far as I can tell, I can't find a single case where  
7   double patenting rejection has been upheld based on a design patent.

8           JUDGE OWENS: We have no more questions.

9           MR. HIEKEN: Thank you very much, Your Honors. I appreciate it.  
10          (Whereupon, at approximately 9:25 a.m., the proceedings were  
11   concluded.)